



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/000,219

12/04/2001

Masafumi Nishitani

Q67539

9175

65565

7590

02/05/2009

SUGHRUE-265550

2100 PENNSYLVANIA AVE. NW

WASHINGTON, DC 20037-3213

EXAMINER

DUONG, THANH P

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

02/05/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING

2  
3 UNITED STATES PATENT AND TRADEMARK OFFICE

4  
5  
6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES

8  
9  
10 Ex parte MASAFUMI NISHITANI  
11 and MASAEI TSURUMAKI

12  
13  
14 Appeal 2008-4625  
15 Application 10/000,219  
16 Technology Center 1700

17  
18  
19 Oral Hearing Held: Tuesday, November 18, 2008

20  
21  
22  
23 Before CHARLES F. WARREN, CATHERINE Q. TIMM, and  
24 MICHAEL P. COLAIANNI, Administrative Patent Judges

25  
26 ON BEHALF OF THE APPELLANT:

27  
28 JOHN BYRD, ESQ.  
29 Sughrue-265550  
30 2100 Pennsylvania Avenue, N.W.  
31 Washington, DC 20037-3213  
32  
33

34

35

36

37

1           The above-entitled matter came on for hearing on Tuesday,  
2 November 18, 2008, commencing at 12:21 p.m., at the U.S. Patent and  
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Suzie,  
4 Notary Public.

5           MS. BOBO-ALLEN: Calendar No. 41, Appeal Number  
6 2008-4625, Mr. Byrd.

7           JUDGE WARREN: Good afternoon, Mr. Byrd.

8           MR. BYRD: Good afternoon.

9           JUDGE WARREN: As you know sir, you have 20 minutes.  
10 You may begin when you are ready.

11           MR. BYRD: May it please the Board, I am John Byrd, and I  
12 am representing Bridgestone Sports Co. Ltd., in this application. The  
13 application includes six independent claims and each of these claims  
14 includes a product by process limitation. I'd like to discuss product by  
15 process limitations, as well as (inaudible) today.

16           Referring to the first independent claim, Claim 1, if you look at  
17 Figure 2, Claim 1 includes the golf club with a shaft, and then a metal head  
18 attached to the shaft. This metal head comprises a body having an opening  
19 in which a striking face member is disclosed. Referring to the product by  
20 process limitations, a striking face member including a plurality of metal  
21 pieces, and these pieces are first fixed together by laser welding, and also  
22 press forming is performed on a variety of metal pieces that are fixed  
23 together, to form a curved surface portion.

24           Each of the independent claims includes similar product by  
25 process limitations. For example, Claim 7 recites plastic working instead of  
26 press forming, but also recites the laser welding operation. So in the

1 rejection, the Examiner acknowledges that the features of laser welding and  
2 press forming are missing from the prior art references. However, the  
3 Examiner has endorsed these features, relying on the fact that they are  
4 product by process limitations.

5           However, the operations or processes that are provided in the  
6 claim do result in structural differences that must be considered by the  
7 Examiner in accordance with MPEP section 2113, where the Examiner  
8 should consider a reference or evidence. We, in the prosecution, we  
9 provided a declaration describing some of the different structural differences  
10 between pieces that are provided by laser welding and press forming, and  
11 those of the prior art.

12           For example, on page three of this 132 declaration, there's a  
13 description about gaps between the pieces in conventional welding, and also  
14 how welding rods fill these gaps. In a piece that is provided by the process  
15 operations of the claims, it would be distinguished from these structures and  
16 would have different features.

17           Another part of the declaration on page five mentions that large  
18 regions are weakened by conventional welding, which provides a brittle  
19 face. So in addition on page seven of the declaration, the exposure welding  
20 requires overlapping structures they would not have in the laser welding.

21           So by use of laser welding to prepare these plates together, the  
22 structural -- the device is structurally different and has increased strength  
23 versus the prior art, and this allows these welded pieces to be aligned  
24 together as a press form member. So essentially the Examiner has not  
25 provided any comments at all about our declaration, and why these structural  
26 differences are there.

1 JUDGE WARREN: Anything else, counselor?  
2 MR. BYRD: That's all, Your Honors.  
3 JUDGE WARREN: Judge Timm?  
4 JUDGE TIMM: No questions.  
5 JUDGE COLAIANNI: No questions.  
6 JUDGE WARREN: Thank you.  
7 Whereupon, at approximately 12:30 p.m., the oral hearing was  
8 adjourned.